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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,110	01/19/2001	Paul A. Puniello	20002.0015	8132
23517	7590	12/18/2003	EXAMINER	
SWIDLER BERLIN SHEREFF FRIEDMAN, LLP			LEE, EDMUND H	
3000 K STREET, NW			ART UNIT	
BOX IP			PAPER NUMBER	
WASHINGTON, DC 20007			1732	

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/764,110

Applicant(s)

PUNIELLO ET AL.

Examiner

EDMUND H. LEE

Art Unit

1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1/19/01. 6) ☐ Other: \_\_\_\_

### DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-30, drawn to a mold for forming a golf ball, classified in class 425, subclass 121.
  - II. Claims 31-36, drawn to a method of forming a golf ball, classified in class 264, subclass 275.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as molding a bowling ball or a bouncing rubber ball.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with John Mulgrew on 12/12/03 a provisional election was made without oral traverse to prosecute the invention of group II, claims 31-36. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Claims 31-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the pins" (cl 31, ln 7) lacks antecedent basis in the claim.

The phrase "placing said core between the pins" (cl 31, ln 7) is indefinite because there must be at least two pins for a center to be placed between pins, however, step c of claim 31 provides at least one pin.

Clarification and/or correction is required.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 31, 32, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue (USPN 5849237). Inoue teaches the claimed process as evident at col 4, lns 8-29; col 5, lns 5-7; figs 1-7.

9. Claims 31, 32, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Puniello (USPN 6129881). Puniello teaches the claimed process as evident at col 7, lns 22-47; and figs 6-9c.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 33, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue (USPN 5849237). The above teachings of Inoue are incorporated hereinafter. Inoue does not teach using a core having at least one layer; providing non-movable pins; and producing a cover having the claimed limitations of claim 36. In regard to using a core having at least one layer, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence since it is not a manipulative feature or step of the claimed process. Further, multi-layered cores are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a multi-layered core in the process of Inoue in order to produce a golf ball having enhanced

performance characteristics. In regard to providing non-movable pins, such is a mere obvious matter of choice dependent on mold equipment availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, non-movable pins are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include non-movable pins in the mold of Inoue as vent pins. In regard to producing a cover having the claimed limitations of claim 36, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, golf ball covers having the claimed limitations are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a cover having the claimed limitations by the process of Inoue in order to provide a golf ball having enhanced performance characteristics.

12. Claims 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Puniello (USPN 6129881). The above teachings of Inoue are incorporated hereinafter. Puniello does not teach using a core having at least one layer; and producing a cover having the claimed limitations of claim 36. In regard to using a core having at least one layer, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence since it is not a manipulative feature or step of the claimed process. Further, multi-layered cores are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at

the time the invention was made to use a multi-layered core in the process of Puniello in order to produce a golf ball having enhanced performance characteristics. In regard to producing a cover having the claimed limitations of claim 36, such is a mere obvious matter of choice dependent on the desired final product and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, golf ball covers having the claimed limitations are well-known in the golf ball art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to produce a cover having the claimed limitations by the process of Puniello in order to provide a golf ball having enhanced performance characteristics.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references teach the state of the art: Cavallaro et al (USPN 5882567); Boehm (USPN 5798071); Brown et al (EP 0384713).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 703.305.4019. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

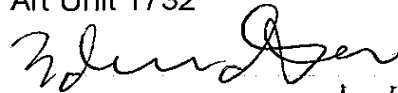
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 703.305.5493. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0661.

EDMUND H. LEE  
Primary Examiner  
Art Unit 1732

  
12/12/04

EHL